

Remarks

This communication is considered fully responsive to the second Office Action mailed November 16, 2004 and made final. Claims 1, 4-12, and 14-27 were examined. Claims 1, 4-12, and 14-27 stand rejected. No claims are amended. No claims are canceled. No new claims have been added. Reexamination and reconsideration of claims 1, 4-12, and 14-27 are respectfully requested.

Premature Final Rejection

The examiner erred in making the second Office Action final because the examiner has introduced new grounds of rejection in the second Office Action that were not necessitated by Applicant's amendment.

The second Office Action rejected claims 1 and 12 under section 112, first paragraph, as failing to comply with the enablement requirement, and under section 112, second paragraph, as being indefinite. However, the recitations introduced to claim 1 by amendment were present verbatim in the application as originally filed in dependent claims 2 and 3. The recitations introduced to claim 12 by amendment were present verbatim in the application as originally filed in dependent claim 13. Yet, the examiner did not reject these recitations under section 112 in his first Office Action.

In addition, the examiner applied the teachings of Arnon for the first time in the second Office Action to reject recitations in amended claims 1, 12, and 21 under section 103(a). However, these recitations were previously presented as dependent claims and were rejected in the first Office Action

under section 103(a) as being unpatentable over Czyszczewski in view of Stevenson. The Applicant successfully argued that Stevenson did not show these recitations, and the examiner instead relied on the teachings of Arnon to reject the same recitations in the second Office Action.

Introducing new rejections and relying on new references in the second Office Action for the first time constitutes new grounds of rejection. The new grounds of rejection were not necessitated by Applicant's amendment because the recitations in the amended claims were earlier presented to the examiner for his consideration in the application as originally filed. Therefore, Applicant respectfully requests withdrawal of the finality of the second Office Action pursuant to MPEP 706.07(d).

Claim Rejections - 35 U.S.C. 112

The Office Action rejected claims 1 and 12 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully traverses this rejection because (1) the Patent Office has failed to meet its burden of proof as to why the disclosure is insufficient, and (2) the disclosure is sufficiently enabling as a matter of law.

The rejection is based on the bare assertion that “[i]dentifying said user-specified remote storage device based at least in part on a path is not disclosed, and therefore is not enabling to one of ordinary skill in the art.” Applicant respectfully notes that dependent claims 2, 3, and 13 included these recitations in the application as originally filed. The examiner is reminded that the claims as originally filed also serve as disclosure of the invention.

Applicant's specification, as originally filed, also discloses at least the following exemplary embodiment, wherein:

. . . the user may request specific data 155. For example, the user may provide the file name of an address book as part of the path in window 310. Specification at page 12, lines 30-32.

In addition, the law presumes that the specification complies with the enablement provision of Section 112 unless the patent examiner provides acceptable evidence or reasoning to suggest otherwise. See, for example, *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1979). The examiner's bare assertion that the disclosure "is not enabling to one of ordinary skill in the art" is insufficient reasoning to support a rejection under Section 112. Mere conclusionary statements will not suffice. *In re Brebner*, 455 F.2d 1402, 173 USPQ 169 (CCPA 1972).

In order to be enabling, the description only needs to provide sufficient detail to enable a person having ordinary skill in the art to practice the invention without undue experimentation. MPEP 2164.01(a) identifies several factors that are to be considered in determining whether the description meets the enablement requirement. A point-by-point consideration of these factors demonstrates conclusively that the originally filed disclosure is sufficient as a matter of law:

1. Nature of the Invention. The present invention is directed to a multifunction device that may be configured to access data (e.g., an address

book or file) that resides on a remote storage device. See, e.g., Specification at page 6, lines 5-12. That is, the present invention is directed to methods for linking a multifunction device to remote storage devices and not to any specific network communications protocol for establishing this link.

The methods are fully described in the specification and drawings. It would be readily apparent to one skilled in the art after having become familiar with the teachings of the invention, and without the need to set forth any specific communications protocol for linking the multifunction device with the remote storage device, methods for specifying a path to the remote storage device. Merely for purposes of illustration, and not intending to limit the scope of the invention, one can readily appreciate that the path can be easily identified using conventional path identifiers, such as, e.g., d:/users/user1/address_books/internal_directory.

Given that the nature of the invention is related to multifunction devices, the description is sufficient in the context of the nature of the invention. While it is true that the description does not contain a detailed discussion of any particular network communications protocol, such detail is not necessary for a complete understanding of the invention. The details are known in the art and can be readily be provided by persons having ordinary skill in the art after having become familiar with the teachings of the present invention.

2. Breadth of the Claims. Each of the currently pending claims is commensurate in scope with the nature of the invention as described in the specification. That is, each of the currently pending claims defines methods of

providing access from a multifunction device to data operatively associated with a user-specified remote storage device. Since each of the currently pending claims is commensurate in scope with the invention described in the specification, the second “sufficiency” factor listed in Section 2164.01(a) of the MPEP is also met.

3. State of the Prior Art. It is indisputable that communications protocols for specifying paths to data on remote storage devices are well-known in the art. It cannot be said that specifying a path to data on a remote storage device is so little known and undeveloped that a person having ordinary skill in the art could not readily provide a suitable method for doing so after having become familiar with the teachings of the present invention.

4. Experimentation. Appellant notes that while a person having ordinary skill in the art may exercise some degree of design choice to provide the user of a multifunction device with methods of specifying a path to data on a remote storage device, such design choice would not be “undue experimentation” for this particular art. It is not unusual to engage in some degree of engineering design choice and modification.

5. Direction Provided by the Inventor. The specification describes how to make and use the invention but does not teach that which is well-known in the art. The omission of details relating to any specific network communications

protocol, of which can be readily provided by one skilled in the art after having understood the teachings of the invention, is not fatal to the patent application.

The Office Action also rejected claims 1 and 12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the examiner asserts that “identifying said user-specified remote storage device based at least in part on a path” is relative and therefore indefinite.

It would be readily apparent to one having ordinary skill in the art that there are other methods of identifying a remote storage device in addition to a user specifying a path to the remote storage device, and that these other methods may also be used in combination with the user specifying a path to the remote storage device. Indeed, Applicant’s originally filed specification discloses at least the following exemplary embodiment, wherein:

. . . the user may select an address book function (e.g., by pressing a key 107 corresponding to the function) at the multifunction device. According to such an embodiment, program code may be provided for searching all of the files at the corresponding remote storage device 150 and identifying compatible file types (e.g., as indicated by the file extension).

Specification at page 12, line 33 to page 13, line 5.

Applicant respectfully requests withdrawal of the Section 112 rejections of claims 1 and 12 for at least the foregoing reasons.

The Office Action also stated that dependent claims 4-11 and 14-20 inherit the Section 112 deficiencies of claims 1 and 12. As discussed above, Applicant believes that the Section 112 rejections are improper with regard to claims 1 and 12 and therefore these rejections should not be applied to the dependent claims.

Claim Rejections - 35 U.S.C. 103(a)

The Office Action rejected claims 1, 4-12, and 14-27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,557,907 to Czyszczewki, et al. (hereinafter referred to as “Czyszczewki”) in view of U.S. Patent No. 6,321,308 to Arnon, et al. (hereinafter referred to as “Arnon”). Applicant respectfully traverses this rejection.

Claim 1 positively recites “identifying said user-specified remote storage device based at least in part on a path thereto specified by a user at said multifunction device” (emphasis added). The cited references fail to teach or suggest at least these recitations.

The Office Action admits that Czyszczewki fails to teach or suggest at least these recitations and instead relies on Arnon (col. 4, lines 60-66). Although the cited passage in Arnon discloses a record having a data portion with “an identifier identifying the target device (disk) and requesting device (controller) . . . ,” there is no disclosure of identifying a user-specified remote storage device based at least in part on a path specified by a user at a

multipunction device. Indeed, there is no teaching or suggestion in Arnon that the user has anything at all to do with identifying the target device.

In addition, the Office Action improperly combined the teachings of Arnon with the teachings of Czyszczewki. It is improper to combine references which do not suggest the properties and results of the claimed invention or that do not suggest the claimed combination as a solution to the problem which the claimed invention solves. *In re Wright*, 6 USPQ2d 1959 (Fed. Cir. 1988) (restricted on other grounds by *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990)). Arnon discloses a remote storage system that may be used to maintain a mirror copy of data stored on the local storage system (e.g., for backup). The teachings of Arnon have nothing to do with the multipunction device of Applicant's invention. The examiner asserts that the motivation for combining the references "is that this system provides queuing scheme, which allows for a high degree of parallelism while maintaining validity of storage system." However, this also has nothing to do with the multipunction device of Applicant's invention.

Even if the teachings of Arnon and Czyszczewki were to be combined, the result would be a multipunction device coupled to a remote storage system for maintaining a mirror copy of data stored at the multipunction device. Thus, the combination still fails to teach or suggest identifying a user-specified remote storage device based at least in part on a path specified by a user at a multipunction device. See MPEP at §2143.03 (mandating that all claim recitations be taught or suggested by the prior art).

For at least the foregoing reasons claim 1 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 4-11 depend from claim 1, which is believed to be allowable. Therefore, claims 4-11 are also believed to be allowable for at least the same reasons as claim 1 and withdrawal of the rejection of claims 4-11 is respectfully requested.

Claim 12 positively recites “identifying a remote storage device having said user-requested data operatively associated therewith based at least in part on a path for said remote storage device specified by a user at said configured multifunction device” (emphasis added). The cited references fail to teach or suggest at least these recitations, as discussed above for claim 1.

For at least the foregoing reasons claim 12 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 12.

Claims 14-20 depend from claim 12, which is believed to be allowable. Therefore, claims 14-20 are also believed to be allowable for at least the same reasons as claim 12 and withdrawal of the rejection of claims 14-20 is respectfully requested.

Claim 21 positively recites “including program code for identifying data operatively associated with a user-specified remote storage device; and program code for accessing said data operatively associated with said user-specified remote storage device from said multifunction device” (emphasis

added). The cited references fail to teach or suggest at least these recitations, as discussed above for claim 1.

For at least the foregoing reasons claim 21 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 21.

Claims 22-27 depend from claim 21, which is believed to be allowable. Therefore, claims 22-27 are also believed to be allowable for at least the same reasons as claim 21 and withdrawal of the rejection of claims 22-27 is respectfully requested.

Conclusion

The Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

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